

## **REMARKS**

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Claims 1-20 were pending in this application. Claims 12-15 and 18-20 have been cancelled, claim 5 has been amended hereby to correct matters of form and claims 1 and 16 have been amended to more particularly point out features of the invention. Accordingly, claims 1-11 16-17 will be pending herein upon entry of this Amendment. Support for the amendment to each of the claims can be found, for example, at Fig. 2 and at paragraphs [0015], [0016]. For the reasons stated below, Applicant respectfully submits that all claims pending in this application are in condition for allowance.

In the Office Action, claim 5 was objected to because of informalities. Claims 1-6, 8, and 12-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McGarrity (U.S. Patent No. 6,438,761) in view of Babay (U.S. Patent No. 6,435,194). Claims 9-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McGarrity in view of Babay and Stafford et al. (U.S. Patent No. 5,395,400). Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Futere et al. (U.S. Patent No. 4,344,189) in view of McGarrity and Babay. To the extent this rejection might still be applied to claims presently pending in this application, it is respectfully traversed.

**Claim Objections**

Claim 5 has been amended to overcome informalities cited by the Examiner.

Accordingly, the objection should be withdrawn.

**Claim Rejections**

Regarding the rejection of claims 1-6 and 8 under 35 U.S.C. §103(a) as unpatentable over McGarrity in view of Babay, Applicant respectfully traverses this rejection. Claim 1 recites, in part, a pad cover comprising a first cover piece and a second cover that are “separate pieces of fabric,” a sleeve portion having a first sleeve piece and a second sleeve piece that are “separate pieces of fabric,” and a “seam joining the first cover piece, the second cover piece, the first sleeve piece and the second sleeve piece.”

In contrast, McGarrity teaches a protective headband having a pad cover. The headband 12 has an inner surface 16 and an outer surface 18. (See McGarrity at col. 3, ll. 1-2.) An oval-shaped backing member 42 is sewn to the inner surface 16 of the headband 12. (See id. at col. 3, ll. 33-35.) A slit 48 is placed into backing member 42, and an insert 14 is inserted through the slit 48 to a position between the headband 12 and the backing member 42. (See id. at col. 3, ll. 38-41 and 51-56.)

In an alternative embodiment, McGarrity teaches to use two cloth strips sewn together around their entire coinciding peripheries and to provide a pocket 46. (See id. at col. 3, ll. 61-67.) A slit 48 for receiving an inset 14 is placed in the inner cloth strip. (See id. at col. 3, l. 67 to col. 4, l. 1.) In yet another embodiment, McGarrity teaches to fold a cloth in half width wise to form the pocket for an inset. (See id. at col. 4, ll. 1-3.)

Thus, none of the above embodiments of McGarrity teach or suggest a pad cover comprising a first cover piece and a second cover piece that are “separate pieces of fabric,” a sleeve portion having a first sleeve piece and a second sleeve piece that are “separate pieces of fabric,” and a “seam joining the first cover piece, the second cover piece, the first sleeve piece and the second sleeve piece,” as recited in claim 1.

The Examiner admits that McGarrity also does not show “the first cover piece and the first sleeve piece made of a first color,” “the second cover piece and the second sleeve piece made of a second color different from the first color,” and “the guard being reversible between a first configuration in which the first color is substantially facing outwardly and a second configuration in which the second color is substantially facing outwardly.”

Babay fails to cure all of the deficiencies of McGarrity. Applicant respectfully traverses the Examiner’s characterization of Babay at page 3 of the Office Action as a “reversible guard.” Babay does not teach a reversible guard, but rather a pony tail holder. The pony tail holder of Babay is comprised of two bunched fabrics. (See Babay Abstract.) Thus, Babay does not teach or suggest the first and second cover pieces, the first and second sleeve pieces, the seam, or the guard recited in claim 1. Because each and every limitation is not taught or suggested by the combination of McGarrity and Babay, the rejection of claim 1 should be withdrawn. The rejection of claims 2-6 and 8 should be withdrawn as well, at least in view of their dependence from claim 1. Further support for the allowance of these claims is described below.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify a reference or to combine reference teachings. Also, there must be a reasonable expectation of success. *See M.P.E.P. § 2143.* McGarrity does not contain any suggestion or motivation for the headband being reversible. Each structural feature of McGarrity indicates that the headband is not reversible. For example, McGarrity at Fig. 3 shows a fastener 30 and loop pad 28 formed on one side of strap 24, indicating the headband is not reversible. Similarly, slit 48 is formed to fit against the forehead to secure the inset in the slot, also indicating the headband is not reversible. McGarrity further teaches at col. 3, ll. 42-60 that the polymeric inset 14 is molded to a user's head so that it permanently matches the exact contour of a user's head. If anything, the custom molded inset teaches away from reversibility. One of ordinary skill in the art would not have a reasonable expectation of success in the guard functioning properly if the headband was reversed so that the inset did not fit the contour of the forehead.

Even if the user could fasten the headband so the slit is facing outwards (which the headband is not designed to do), remove the inset and re-insert it so that it fits the contour of the forehead, the inset may fall out of the slit since it is not secured to the user's forehead. McGarrity does not suggest providing a reversible guard. Babay, which relates to a pony tail holder, also does not provide any motivation for modifying a guard protector so that it is reversible.

Therefore, Applicants submit that independent claim 1 is allowable, for the reasons argued above. In addition, dependent claims 2-6 and 8 are also allowable at least by virtue of

their respective dependencies from allowable base claim 1. Therefore, Applicants respectfully submit that the Examiner should withdraw the 35 U.S.C. § 103(a) rejection of these claims.

Regarding the rejection of claims 16 and 17 under 35 U.S.C. §103(a) as unpatentable over McGarrity in view of Babay, Applicant respectfully traverses this rejection for similar reasons to those set forth regarding claim 1. Specifically, a combination of McGarrity and Babay does not teach or suggest a first cover piece and a second cover piece that are “separate pieces of fabric,” a sleeve portion having a first sleeve piece and a second sleeve piece that are “separate pieces of fabric,” and “sleeve portion being attached at a seam joining the first cover piece, the second cover piece, the first sleeve piece and the second sleeve piece,” as recited in independent claim 16. Even if a combination of McGarrity and Babay were proper (which Applicant disputes for the same reasons described above with respect to claim 1), the combination does not teach each and every feature recited in claim 16. Accordingly, claim 16 and dependent claim 17 should be allowed.

Regarding the rejection of claims 9-11 under 35 U.S.C. §103(a) as unpatentable over McGarrity in view of Babay and further in view of Stafford et al., the rejection should be withdrawn at least in view of their dependence from allowable claim 1. Notably, Stafford et al., which relates to heated headgear (and not a “protective guard” as described at page 4 of the Office Action), does not cure the deficiencies of McGarrity and Babay.

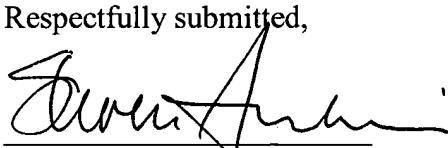
The rejection of claim 7 under 35 U.S.C. §103(a) as unpatentable over Futere et al. in view of McGarrity and Babay should be withdrawn at least in view of its dependence from allowable claim 1. Futere, which the examiner relies upon for disclosing a stirrup, does not cure

the deficiencies of a combination of McGarrity and Babay, as described above. Futere discloses a front panel piece attached to a liner panel piece with a protective pad and back panel inserted between. (Futere et al. at Fig. 3 and at col. 5, ll. 65 to col. 6, ll. 21.) Even if a combination of Futere, McGarrity and Babay was proper (which Applicant disputes), the combination does not teach or suggest a first cover piece and a second cover piece that are "separate pieces of fabric," a sleeve portion having a first sleeve piece and a second sleeve piece that are "separate pieces of fabric," and "sleeve portion being attached at a seam joining the first cover piece, the second cover piece, the first sleeve piece and the second sleeve piece," as required by dependent claim 7. Accordingly, the claim should be allowed.

In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone applicant's undersigned representative at the number listed below.

PILLSBURY WINTHROP SHAW PITTMAN LLP  
1650 Tysons Boulevard  
McLean, VA 22102  
Tel: 703/770-7687

Date: October 12, 2005

Respectfully submitted,  
By:   
Steven P. Arnheim  
Registration No. 43,475

SPA:kmk

Customer No. 28970